

REMARKS

Applicant respectfully requests reconsideration in view of the following remarks and amendments. Claims 4, 10 and 11 are amended. Accordingly, claims 4-8, 10 and 11 are pending in the application.

I. Claims Rejected Under 35 U.S.C. § 103

Claims 4 and 6-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,836,565 issued to Nishikawa (hereinafter “Nishikawa”).

Claim 4, as amended, recites the elements of “the information extracted by the second extraction method is information that cannot be visually seen,” and “the information is MTF characteristics of a scanner that has scanned an image corresponding to the image data, the MTF characteristics have been added to the image data of the image file.” Support for the amendments may be found, for example, in paragraphs [0034]-[0036] of the Specification. Nishikawa fails to teach or suggest these elements as discussed below.

Instead, Nishikawa in Fig. 11 teaches that reduced image data as shown in Fig. 2 is extracted (that the Examiner has characterized as “a second extraction method”). In the Response to Arguments (see page 3 of the Office Action), the Examiner further notes, “[i]f the tag cannot be used, the gamma correction value can be determined from reduced image data.” As taught by Nishikawa, “[r]educed image data means image data obtained by reducing the resolution of original image data to decrease the number of pixels . . . [and] [a] so-called thumbnail image and a preview image that displays the outline of original image data before it is displayed on the image display section 13 are also included in the reduced image data” (emphasis added). Nishikawa, column 4, lines 2-10. Therefore, the reduced image data of Nishikawa should be understood as being a *smaller depiction* of the original image and also includes *thumbnail and preview versions* of the original image data. Consequently, Nishikawa fails to teach or suggest the elements of “the information extracted by the second extraction method is information that cannot be visually seen,” as recited in amended claim 4.

Further, in the Office Action, extraction of information from “Reduced Image Data” in Nishikawa is alleged to correspond to the claimed second extraction method as recited in claim 4.

However, the present invention as recited in amended claim 4 is characterized in that information related to MTF characteristics of a scanner, which cannot be extracted from image data themselves, has been added to the image data. Thus, it becomes possible to output high quality images by utilizing, at the time of outputting an image, such information that cannot be extracted from the image data itself. However, in Nishikawa, information is *extracted from image data itself* and information related to MTF characteristics of a scanner cannot be extracted in the manner recited in amended claim 4. Therefore, the extraction of information from the image data in Nishikawa does not correspond to the second extraction in the manner recited in amended claim 4 according to the present invention. Thus, for at least these reasons, Nishikawa fails to teach or suggest the elements of “the information is MTF characteristics of a scanner that has scanned an image corresponding to the image data, the MTF characteristics have been added to the image data of the image file,” as recited in amended claim 4.

Thus, in view of at least the foregoing reasons, Nishikawa fails to teach each element of claim 4. In addition, claims 6-8 are patentable over Nishikawa because each of these claims depends on claim 4. Accordingly, reconsideration and withdrawal of the rejection of claims 4 and 6-8 are respectfully requested.

With respect to claims 10 and 11, these claims, as amended, recites analogous elements to those in amended claim 4. Therefore, for at least the reasons mentioned in connection with amended claim 4, Nishikawa fails to teach or suggest each element of amended claims 10 and 11 as well. Accordingly, reconsideration and withdrawal of the rejection of claims 10 and 11 are respectfully requested.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Nishikawa in view of U.S. Patent Publication No. 2003/0048922 filed by Rhoads (hereinafter “Rhoads”) in view of U.S. Patent No. 2003/0032033 filed by Anglin et al. (hereinafter “Anglin”).

With respect to claim 5, this claim depends on 4 and incorporates the limitations thereof. Therefore, for at least the reasons mentioned in connection with amended claim 4, Nishikawa fails to teach each element of claim 5. In addition, Rhoads and Anglin fail to teach or suggest the missing elements of amended claim 4. The Examiner has not cited and Applicant is unable to discern the portions of Rhoads and Anglin that allegedly teach or suggest the missing elements of

claim 4. Consequently, for at least these reasons, Nishikawa in view of Rhoads in further view of Anglin fails to teach or suggest each element of claim 5 because of its dependency on amended claim 4. Accordingly, reconsideration and withdrawal of the rejection of claim 5 are respectfully requested.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (408) 720 8300.

Respectfully submitted,

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Angela Quinn

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